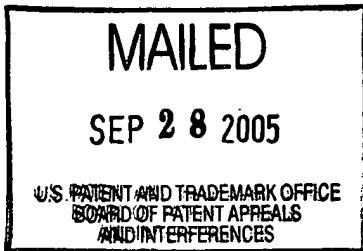


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHIKAZU SAKAMOTO
and HIROSHI YOSHIDA

Appeal No. 2005-1371
Application No. 09/456,833

HEARD: September 14, 2005

Before MCQUADE, CRAWFORD and BAHR, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Yoshikazu Sakamoto et al. appeal from the final rejection of claims 1 through 11, 14, 29, 31 and 35 through 42, all of the claims pending in the application.

THE INVENTION

The invention relates to "a gaming machine in which a player can reliably and effectively recognize special game information" (specification, page 1). Representative claim 1 reads as follows:

1. A gaming machine comprising:
a variable display section for variably displaying a plurality of kinds of symbols necessary for gaming;
a starting device for starting variable display of the symbols; and
a stopping device, disposed so as to be operable by a player, for stopping said symbols being variably displayed;
wherein, on condition that a combination of symbols displayed when said symbols are stopped constitutes a predetermined special winning mode, said player is allowed to start playing a special game which is more advantageous to said player than is a normal game said special game having a first mode and a second mode allowed from the first mode;
wherein said gaming machine further comprises an image display section for displaying special game information in said special game to said player, and
wherein said special game information is displayed by figures representing objects and is presented as a progressing story so that when said player is allowed to start playing games in said special game a progressing story begins for said first mode and, when said second mode is allowed, a new progressing story which is related to said first mode begins, said new progressing story being distinguishable by said player from progressive story in said first mode.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Slomiany et al. (Slomiany)	6,159,098	Dec. 12, 2000
Shimizu et al. (Shimizu)	6,227,970	May 08, 2001
Claypole et al., British Patent Document (Claypole)	2,262,642	Jun. 23, 1993
Okada et al., European Patent Document (Okada)	0,875,870	Nov. 04, 1998

THE REJECTION

Claims 1 through 11, 14, 29, 31 and 35 through 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Slomiany in view of Shimizu, Claypole and Okada.

Attention is directed to the main and reply briefs (filed September 17, 2003 and April 9, 2004) and answer (mailed February 11, 2004) for the respective positions of the appellants and examiner regarding the merits of this rejection.¹

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DISCUSSION

Slomiany discloses a slot machine "operable in a basic mode to play a 'basic' slot machine game and in a bonus mode to play a 'bonus' or secondary game" (column 3, lines 8 through 10). The machine 10 comprises a display window 12 for the basic game (three spinning reels 14, 16 and 18) and a video display 24 for various graphics associated with the basic game and/or bonus game. Entry into the bonus game, which has a higher expectation of winning than the basic game, occurs upon a particular outcome of the basic game. The exemplary bonus game described in detail

¹ Counsel pointed out a typographical error in the reply brief in a paper filed April 21, 2004 and a further typographical error in the main brief (on page 3, line 1, "indistinguishable" should be --distinguishable--) at the oral hearing.

by Slomiany (see column 7, line 1 et seq. and Figures 5 through 10) has two categories of awards:

A first award type in the bonus game is a selection-based award in which the player is credited an amount of coin(s) or credit(s) based on the value (or cumulative value) of the selection elements selected in the bonus game. A second award type in the bonus game is a quantity-based award in which the player is credited an amount of coin(s) or credit(s) based on the number of successful trials of the bonus game [Abstract].

Implicit in the examiner's explanation of the appealed rejection (see pages 3 through 7 in the answer) is an acknowledgment that Slomiany lacks response to:

a) the limitations in independent claim 1 requiring the display of special game information to be presented as a progressing story so that when a player is allowed to start playing games in the special game a progressing story begins for a special game first mode and, when a special game second mode is allowed, a new progressing story which is related to said first mode begins, with the new progressing story being distinguishable by said player from progressive story in said first mode;

b) the limitations in independent claim 14 requiring (1) the display of an outcome of each of a predetermined number of special games, (2) the display of special game information by figures representing objects and as a progressing story, and (3)

a device for allowing a player to interact with the objects and exert control over the displayed action as the story progresses; and

c) the limitations in independent claim 35 requiring the display of special game information results simultaneously showing individual outcomes of past plays in a first special game mode and individual outcomes of past plays in a second special game mode.

To overcome these deficiencies in Slomiany, the examiner looks to Shimizu, Claypole and Okada, all of which also disclose slot machines.

The Shimizu machine includes a main display device, a sub-display device for various items of information including machine specifications and a history of game results, and a plurality of pushbuttons for operating the machine.

The Claypole machine comprises a spinning reel display and a separate video screen for displaying interactive games of skill, advice on operating the machine, a player's winnings, the value of progressive jackpots and the operational conditions of the machine.

The Okada machine includes a principal display for a spinning reel game, stop buttons for controlling the spinning

reels, and a secondary display for additional games, bonus games, machine information, result histories, and a progressive story which is predictive of the expectation of winning the spinning reel game.

The following passage sets forth the examiner's position for combining Slomiany, Shimizu, Claypole and Okada to reject the appealed claims:

One of ordinary skill in the art would be motivated to combine the above well known features described in the references using the following motivation of the references: In Slomiany, the bonus game may be played with any basic game and all that is required is that the bonus game is triggered upon the occurrence of a special event or outcome in the basic game (column 12), Shimizu discloses that the operation portion of the game machine is provided with four push button switches that are operated with particular high frequency during the game and that the functions assigned to these switches can be properly changed. The combination of the above references clearly teaches to one of ordinary skill in the art that a player using stop reel buttons and results in a special hit which results in a bonus game and advantageously contains a[n] additional display with game specific information. In addition, one would be motivated to combine these references in order to provide improved communication and information to the user of a game machine as disclosed above and since the references disclose that the information can be displayed in multiple places such as the main display, auxiliary display or both or a combination of displays. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have a game machine with a basic game and a bonus game with a screen that is used to display the following[:] information relevant to the playing of the gaming machine including historical information, game information, error indication, and special game

information which is information related to a special game is displayed by figures representing objects and written information presented as a progressing story. Additionally it would be apparent to one of ordinary skill in the art that the use of stop buttons to play a main game that are well known can be used for other game functions as taught above [answer, pages 6 and 7].

Obviousness under § 103(a) cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In other words, it is impermissible to use the claimed invention as an instruction manual or template to effect a hindsight reconstruction of the invention by selectively picking, choosing and piecing together isolated disclosures in the prior art. Id. The examiner has done just this in the present case under the unduly broad, and somewhat ambiguous, rationale of providing a game player with improved communication and information. Although the applied references arguably disclose all of the elements of the subject matter recited in independent claims 1, 14 and 35, the collective teachings of these references do not contain any suggestion or motivation to combine such teachings in the particular manner necessary to arrive at such subject matter.

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Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1, 14 and 35, and dependent claims 2 through 11, 29, 31 and 36 through 42, as being unpatentable over Slomiany in view of Shimizu, Claypole and Okada.

SUMMARY

The decision of the examiner to reject claims 1 through 11, 14, 29, 31 and 35 through 42 is reversed.

REVERSED


JOHN P. MCQUADE
Administrative Patent Judge

MURIEL E. CRAWFORD
Administrative Patent Judge

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JENNIFER D. BAHR
Administrative Patent Judge

JPM/gjh

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